

PATENT

HP Docket No.: 10005619-1

App. Serial No. 09/809,150

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REMARKS

In response to the Appeal Brief filed on 11/16/06, prosecution has been reopened. A new grounds of rejection was provided in the Office Action.

Claims 1-9, 21-23, and 28-30 are pending of which claim 1 is independent.

Claims 1-8, 21-23 and 28-30 were rejected under 35 U.S.C § 103(a) as being unpatentable over Morimoto (2002/0013774) in view of Stolfo et al. (2001/0044785).

Claim 9 was rejected under 35 U.S.C § 103(a) as being unpatentable over Morimoto (2002/0013774) and as applied to claim 8, and further in view of Gregory (6,490,567).

These rejections are respectfully traversed for the reasons stated below.

REJECTIONS UNDER 35 USC §103(a)

The test for determining if a claim is rendered obvious by one or more references for purposes of a rejection under 35 U.S.C. § 103 is set forth in MPEP § 706.02(j):

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Therefore, if the above-identified criteria are not met, then the cited reference(s) fails to render obvious the claimed invention and, thus, the claimed invention is distinguishable over the cited reference(s).

1. Claims 1-8, 21-23 and 28-30 were rejected under 35 U.S.C § 103(a) as being unpatentable over Morimoto (2002/0013774) in view of Stolfo et al. (2001/0044785).

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Claim 1 recites,

(d) transforming the information into the predetermined communication protocol and predetermined display format that is suitable for the client device at the mediator; and

(e) sending the transformed information via a network to the client device from the mediator.

The rejection alleges that Morimoto discloses these features in paragraph 43.

Paragraph 43 discloses the personal broker agent may use XML to communicate with entities.

The Applicants' patent application was filed March 14, 2001. Morimoto was filed after the Applicants' patent application on June 29, 2001. Morimoto is a CIP of 09/613,339 filed on July 10, 2000. Thus, Morimoto contains new matter not entitled to the priority date of July 10, 2000. Paragraph 43 of Morimoto is not in 09/613,339 as originally filed. Thus, paragraph 43 is new matter not entitled to the priority date of July 10, 2000. Hence, paragraph 43 cannot be used to reject the claimed subject matter, and thus Morimoto fails to teach or suggest the features described above.

Furthermore, paragraph 43 simply discloses using XML to communicate between entities. Morimoto fails to disclose transforming the information into the predetermined communication protocol and predetermined display format that is suitable for the client device at the mediator. Instead, the information in Morimoto is already in XML format, so no transformation takes place.

Claim 1 also recites,

(a) receiving a request for a web page from the client device;

(b) sending the request to a merchant web site.

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The rejection alleges Morimoto discloses receiving a request for a web page from the client device and sending the request to a merchant web site in paragraphs 39 and 41. In particular, the rejection alleges "sending the request to a merchant web site" is the URL link of the seller disclosed in paragraph 39.

Paragraph 39 discloses that the web site may only provide information to client computer users by providing links to buyers and sellers. However, paragraph 39 does not disclose receiving a request for a web page from a client device and sending the request to a merchant web site. Simply because Morimoto discloses providing a URL to a client computer does not require Morimoto to send a client request to a merchant web site. Instead, the web site may search for web sites having desired products and provide the URLs of those web sites to the client. Conducting a search of web sites providing desired products, does not require sending the client request for the products to those web sites. Thus, Morimoto fails to teach or suggest sending the client request to a merchant web site.

Neither Morimoto nor Stolfo et al. singly or in combination teach or suggest the features described above. Accordingly, claims 1-9, 21-23 and 28-30 are believed to be allowable.

Morimoto in view of Stolfo et al. fails to teach or suggest many of the features of the dependent claims.

Claim 2 recites providing at least one mediated e-commerce service for a merchant. The rejection alleges the shopping cart disclosed in paragraph 44 of Morimoto discloses this feature. Paragraph 44 disclose a shopping cart used at a merchant web site. Thus, the shopping cart service is not mediated. The features of claim 3 are also not taught or suggested by Morimoto for this reason.

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Claim 5 recites transforming information into one of HTML or VML. The rejection alleges paragraph 34 of Morimoto discloses this feature. However, paragraph 34 mentions neither HTML or VML. If this rejection is maintained, the Examiner is requested to indicate where in paragraph 34 these features are taught.

Claim 6 recites XML. The rejection alleges paragraph 43 of Morimoto discloses this feature. However, paragraph 43 is not prior art for the reasons stated above.

Claims 7 and 8 recite features directed to mediated services for updating a shopping cart record. As indicated above, paragraph 44 of Morimoto disclose a shopping cart used at a merchant web site. Thus, the shopping cart service is not mediated. Similarly, the features of claim 9 are not mediated. Morimoto fails to disclose a mediator handling payment to a merchant.

In the rejection of claim 22, the Examiner takes Official Notice to the features in claim 22. The Official Notice is traversed. Applicants do not believe these features are well known. Because, the Official Notice is traversed, the Examiner must provide a reference disclosing the features of claim 22 in the next communication or allow the claim.

Claims 28-30 were rejected over paragraph 43 of Morimoto. However, paragraph 43 is not prior art for the reasons stated above.

2. Claim 9 was rejected under 35 U.S.C § 103(a) as being unpatentable over Morimoto (2002/0013774) and as applied to claim 8, and further in view of Gregory (6,490,567). Claim 9 is believed to be allowable for at least the reasons claim is believed to be allowable.

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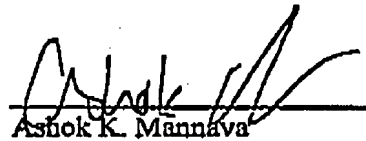
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As all of the outstanding rejections have been traversed and all of the claims are believed to be in condition for allowance, the Applicants respectfully request issuance of a Notice of Allowability. If the undersigned attorney can assist in any matters regarding examination of this application, the Examiner is encouraged to call at the number listed below.

Respectfully submitted,

Date: July 3, 2007

By



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